

Appl. No. 10/676,397
Docket No. 9047MQ
Amdt. dated 04/10/07
Reply to Office Action mailed on 03/08/07
Customer No. 27752

REMARKS

Claim Status

Claims 1-6 and 18-19 are currently under consideration. No additional claims fee is believed to be due.

Claims 9-16 have been withdrawn as a result of an earlier restriction requirement.

Claim 17 is cancelled without prejudice.

Claim 1 has been amended to recite that the tissue paper product is made from a papermaking furnish. Support for the amendment is on p. 3, lines 27-34 of the Specification.

Claim 19 has been added to recite that the tissue paper product comprises from about 0.3 kg/ton to about 1 kg/ton of a charge biasing species. Support for this amendment is in previously presented Claim 17 and on p. 7, lines 15-18 of the Specification.

It is believed these changes do not involve any introduction of new matter. Consequently, entry of these changes is believed to be in order and is respectfully requested.

Rejection Under 35 USC §112, Second Paragraph

The Office Action notes that Claim 1 provided no antecedent basis for the term "the furnish." As amended, Claim 1 recites a "tissue paper product made from a papermaking furnish" thereby providing antecedent basis for the term "the furnish." Consequently, Applicants respectfully request withdrawal of the rejection under 35 USC §112, Second Paragraph.

Rejection Under 35 USC §103(a) Over US 5,810,972

Claims 1-8 have been rejected under 35 USC §103(a) as being unpatentable over US 5,810,972 (hereinafter "Reinheimer"). This rejection is traversed on the grounds that

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Reinheimer does not establish the *prima facie* case of obviousness because Reinheimer fails to teach or suggest all of the claim limitations in Claim 1 (of which Claims 2-8 are dependent). MPEP §§ 2142-2143, In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

As amended, Claim 1 recites from about 0.005% to no more than 0.1% by weight, based on the weight of cellulose, of xylan added to the papermaking furnish. The Office Action dated March 8, 2007 states that while Reinheimer teaches that when xylan is used as the sole hemicellulose component, the addition of xylan taught is outside of the claimed range, but when added as a birch pulp, falls within the claimed range. (Office Action dated March 8, 2007, p. 3). Further, the Office Action argues that the levels of xylan are much lower in birch pulp than the natural levels that the Applicants had based their previous calculations on (Office Action dated March 8, 2007, p. 5) but provides no reference that discloses such low levels. Finally, the Office Action argues that because the Applicants disclose adding a xylan pulp to the furnish in the preferred range of from about 4% to about 6% (Office Action dated March 8, 2007), which the Applicants recognize as falling within the teachings of Reinheimer (Reinheimer, Claim 11), then Reinheimer makes obvious the Applicants' claimed invention. The Applicants respectfully submit that a less preferred range is also disclosed (from about 0.1% to about 10%, Specification, p. 6, lines 27-28), and that it is possible for the low levels of xylan as claimed to result from the use of less pulp than is disclosed by Reinheimer (i.e., from about 0.1% to less than 1% of pulp). The Office Action provides no reference or teaching that one of skill in the art can rely on to prove that the 1% to 6% of birch pulp provides the low level of xylan as is claimed. Therefore, absent some teaching, suggestion, or motivation, the Office has failed to provide the references required to establish the *prima facie* case of obviousness. Ex parte Humphreys, 24 USPQ2d 1255 (B.P.A.I., 1992).

The Applicants maintain that Reinheimer discloses a higher amount of xylan than is claimed and provides no teaching, suggestion, or motivation to one of skill in the art to make the Applicants' claimed invention thereby failing to establish the *prima facie* case of obviousness.

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Claim 18: Cationic Fixing Species

Claim 18 recites, *inter alia*, a cationic charge biasing species having a molecular weight of no more than about 500,000, and that this cationic charge biasing species is present in the level of from about 0.1 kg/ton to about 2 kg/ton. It is well settled that to establish a *prima facie* case of obviousness, the Office must show "some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." In re Fine, 837 F.3d 1071, 1074, 5 USPQ3d (BNA) 1596, 1598 (Fed. Cir. 1988).

Nowhere in Reinheimer is there any disclosure that the charge biasing species is a low molecular weight (no more than about 500,000) cationic synthetic polymer, nor is there any disclosure of the specified range of cationic charge biasing species as is claimed by the Applicants.

The Applicants respectfully submit that the combination of a molecular weight limitation, as well as a formulation limitation, are well beyond the scope of merely optimizing results as limited by 35 U.S.C. §103(a). It has been held improper for the Office to argue that one of skill in the art would "try varying every parameter of a system in order to optimize the effectiveness of the system even if there is no evidence in the record that the prior art recognized that particular parameter affected the result. As [the court has] said many times, obvious to try is not the standard of 35 USC 103 ... [d]isregard for the unobviousness of the results of 'obvious to try' experiments disregards the 'invention as a whole' concept of §103." In re Antonie, 559 F.2d 618, 620, 195 USPQ 6, 8 (C.C.P.A. 1977).

Therefore, because Reinheimer does not provide any teaching, suggestion, or motivation for one of ordinary skill in the art to make a product with from about 0.1 kg/ton to about 2 kg/ton of a cationic charge biasing where the cationic charge biasing species has a molecular weight of no more than 500,000, the Applicants respectfully request removal of the obviousness rejection.

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Conclusion


In light of the above remarks, it is requested that the Examiner reconsider and withdraw the rejection under 35 USC §103(a).

This response represents an earnest effort to place the application in proper form and to distinguish the invention as now claimed from the applied references. In view of the foregoing, reconsideration of this application and allowance of Claims 1-6 and 18-19 are respectfully requested.

Respectfully submitted,

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